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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,489	10/26/2000	Van L. Phillips	FLEXFT.146CP2	6577

20995 7590 06/04/2003

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT PAPER NUMBER

3738

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/698,489

Applicant(s)

PHILLIPS ET AL.

Examiner

Jackson J Suzette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 7, 10, 62 and 66-129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 62 and 66-78 is/are allowed.
- 6) ☒ Claim(s) 1, 7, 79-89, 94, 96, 98-107, 111, 113-121, 126, 128 and 129 is/are rejected.
- 7) ☒ Claim(s) 10, 90-93, 95, 97, 108-110, 112, 122-125 and 127 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's amendment and RCE dated 5/20/03 have been received in application serial number 09/698,489. An election of species was made without traverse in paper no. 10 to elect species O (figures 21-22). Claims 2-6, 8-9, 11-61 and 63-65 have been officially canceled.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 7, 79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merlette 4,959,073. Merlette discloses the invention as claimed (noting figures 1, 6 and 7) a foot plate element (20); at least one ankle plate element (14); an ankle block comprising a relatively soft, compressible material (26) sandwiched between the ankle plate element and the foot plate element; at least one cylindrical opening (28) extending at least partially through the ankle block. It is obvious to one having ordinary skill in the art that when viewed collectively that the "ankle block provides *substantially* (see MPEP 2173.05(b) *substantially*) the sole means of support and connection between the foot plate element and the ankle plate element it is also obvious by the alternative embodiment described by Merlette (see 6, lines 56-68) that the plastic toe cap would

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also further distinguish the ankle block as *the sole means of support* because it would separate the foot and ankle plates. The intended use recitation/functional language of claim 81 "...flex in a cooperative manner to provide substantially smooth and continuous rollover transition from heel-strike to toe-off" carries no patentable weight in the absence of any distinguishing structure. "Merlette" clearly discloses the structure as claimed and is found to be inherently capable of performing the function.

4. Claims 82-89, 94, 96, 98-107, 111, 113-121, 26, 128-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington 2,357,893. Harrington discloses the invention as claimed noting figures 1-4 comprising: a foot plate element; (8); at least one leg plate element (3) disposed above the foot plate element; and at least one ankle block (12,13) positioned between the ankle plate element and foot plate element; an ankle block which includes at least on cylindrical opening that extending at least partially or totally there through (14); a stiffener/core (14); wherein the block is made of a compressible material (col. 2, lines 13-15); wherein the block is substantially the sole means of support and connection between the foot plate element and ankle plate. However, **(a)** Harrington does not specify the term "ankle plate" rather "leg plate". It is obvious to one having ordinary skill in the art that the lower extremity of the leg *is the ankle* and that the *leg plate* is incorporated into the ankle plate (see col.2, lines 47-48). **(b)** Harrington further does not specify that the ankle block is urethane but Harrington does state in col.2, line 18-19 that block (12, 13) is rubber. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the flexible rubber is urethane because it is known for its flexing properties.

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***Allowable Subject Matter***

5. Claims 10, 90-93, 95, 97, 108-110, 112, 122-125, 127 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 62, 66-78 is allowed.

***Response to Arguments***


7. Applicant's arguments filed 5/20/03 have been fully considered but they are not persuasive. Applicant amends the claims and contends that Merlette is a single piece composite and that the resilient material of Merlette does not provide substantially the sole means of support. It is the examiner's opinion that Merlette (when viewed collectively) does meet the limitations as *claimed* (see paragraph 3 with regards to the term *substantially*). The claims are article claims not method claims thus the structure of Merlette's prosthesis do read upon the current claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Merlette et al. 6,398,818; Merlette 6,261,324; Phillips 5,993,488; Phillips 5,800,569 all show related material.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.
10. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3580.
11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Suzette J. Jackson  
30 May 30, 2003